**II. Claim Rejections -- 35 U.S.C. § 103(a)**

*A. Claims 1, 5, 10, 11, 22, and 23*

Claim 1 recites a unique combination of features including, *inter alia*, "extracting a telephone number from the stored string of character information" (*see also* claims 5, 10, 11, 22, and 23). The Examiner acknowledges that Bayless fails to teach or suggest this recited feature (*see* Office Action, pages 3, 5, and 6). The Examiner alleges that JP 09-055815 makes up for this deficiency of Bayless. Applicant respectfully disagrees.

In particular, the Examiner alleges that JP 09-055815 teaches an extraction means (*i.e.*, controller 3-1) "for extracting a telephone number from the stored string of character information . . . in order to cooperate (sic: cooperatively) control a telephone terminal equipment". JP 09-055815 describes telephone terminal equipment and a telephone exchange system for containing the equipment.

The slave controller 3-1 of JP 09-055815 performs communication function processing control (*see* Abstract). This slave control unit 3-1 in the telephone terminal unit 1-1 is a line trunk controller, which performs circuit sending-and-receiving control (*see* Fig. 4 and ¶¶ 48-49 of JP 09-055815). The telephone terminal unit 1-1 of JP 09-055815 can display various windows/screens (*see* Fig. 7), which may include circuit keys for registering various circuits and for auto-dialing (*see* Fig. 8 and ¶ 88). In JP 09-055815, dialing is effected via a (ten-key) dialing key window 6-9 (*see* Fig. 9), while auto-dialing is effected through registration via a keyboard section 10-3 (*see* Fig. 13 and ¶ 112).

Both ten-key dialing and shortcut dialing via a telephone panel window are known (*see, e.g.,* Applicant's page 1, line 17 to page 2, line 4). Thus, the manual entry of phone digits to be dialed and the storing of shortcuts for the phone numbers to be dialed, as described in JP 09-055815, fail to teach or suggest (either by the slave controller 3-1 or otherwise) "extracting a telephone number from the stored string of character information", as recited in claim 1 (*see also* claims 5, 10, 11, 22, and 23).

Furthermore, the present invention is related to information processing equipment (*see, e.g.,* claims 1, 5, 10, and 11) with a display, such as a personal computer (PC) or a personal digital assistant (PDA), and is not directed to telephone equipment. Conversely, JP 09-055815 is related to a display type telephone terminal in which a window is opened on a large-size display panel and two CPUs communicate with each other through a common memory.

Even further, in the present invention, the information processing equipment deals with data displayed on the display panel and processed by software other than a telephone OS installed in the equipment. Thus, the data may include a string of character information from which a telephone number is extracted, and the data may be obtained from any other source or system. Conversely, in JP 09-055815, both the display and the telephone are operated and controlled by the telephone OS of the telephone terminal. Consequently, JP 09-055815 fails to teach the use of displayed data, which is processed by other software.

Additionally, the Examiner alleges that "it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included within [Bayless] steps and

means to extract a telephone number from the stored string of character information . . . as taught by JP 09-055815 for the purposes of cooperatively controlling a telephone terminal equipment as suggested by JP 09-055815 in Abstract, line 3" (emphasis added). Applicant respectfully disagrees because the Examiner has failed to establish a *prima facie* case of obviousness by demonstrating some reasonable suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings, absent impermissible hindsight.

As the Federal Circuit recently reminded us, the USPTO is held to a *rigorous* standard when trying to show that an invention would have been obvious in view of the combination of two or more references. *See*, *In re Sang Su Lee*, 2002 U.S. App. LEXIS 855, *10 (Fed. Cir. 2002), *citing*, *e.g.*, *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) ("Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references."). The Federal Circuit goes on to emphasize that the "need for specificity pervades this authority." *In re Sang Su Lee* at *10-*11 (emphasis added) (*citing In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) ("particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed")).

Applicant respectfully submits that the current grounds of rejection do not satisfy the Federal Circuit's standard for demonstrating that the claimed invention would have been obvious in view of the combination of Bayless in view of JP 09-055815.

Specifically, Bayless describes a telecommunication system that provides for telephone functions to be accessed through a client computer system, and wherein a server computer system provides telephony services, database services, and access to e-mail, voice mail, video conferencing, and facsimile systems (*see* Abstract of Bayless). Conversely, JP 09-055815 describes telephone terminal equipment and a telephone exchange system for containing the equipment, directed to accelerating a line acquisition speed by sharing the control of processing relating to display device control and communication control and cooperatively controlling a telephone terminal equipment (*see* Abstract of JP 09-055815). Thus, given these fundamental differences, even if, assuming *arguendo*, Bayless was modified to include a means for extracting a telephone number from a stored string of character information, Bayless would not cooperatively control a telephone terminal equipment as alleged by the Examiner. Consequently, the Examiner has provided no reasonable suggestion or motivation, absent impermissible hindsight, to modify Bayless to include a means for extracting a telephone number from a stored string of character information.

For at least the above reasons, claim 1 (*see also* claims 5, 10, 11, 22, and 23) is patentable over Bayless and JP 09-055815.

*B. Claims 2-4, 6-9, and 12-21*

Claims 2-4, 6-9, and 12-21 are patentable over Bayless in view of JP 09-055815 at least by virtue of their dependency.

**III. Conclusion**

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned attorney at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

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